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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,909	03/10/2004	Heinrich Salzer	SALZER-1	3379

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COLLARD & ROE, P.C.
1077 Northern Boulevard
Roslyn, NY 11576-1696

11/01/2007

EXAMINER

PAINTER, BRANON C

ART UNIT	PAPER NUMBER
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3633

MAIL DATE	DELIVERY MODE
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11/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/797,909	SALZER, HEINRICH	
	Examiner	Art Unit	
	Branon C. Painter	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5-8 is/are rejected.
- 7) ☒ Claim(s) 2 and 4 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eichhorn (U.S. Patent No. 6,240,685) in view of Stibolt (U.S. Pub. No. 2003/0070370).

- a. Eichhorn discloses a cover element for the opening of a building, including:

- i. "Two mutually opposite visible sides which are each provided with a plurality of glass fields..." (Figure 1).
- ii. "...which are each delimited by regions made of a metallic material..." (Figure 1; "the simulated muntins may be...metal", column 4, lines 18-19;).

- iii. "...between which a glass pane is arranged which extends substantially over the entire surface of the sheet-metal plate..." (Figure 1).
- iv. "...with the glass fields each having a size which prevents the penetration by persons, with the glass pane and the sheet metal plate being arranged within frame elements enclosing the cover element in circular fashion..." (Figure 1).

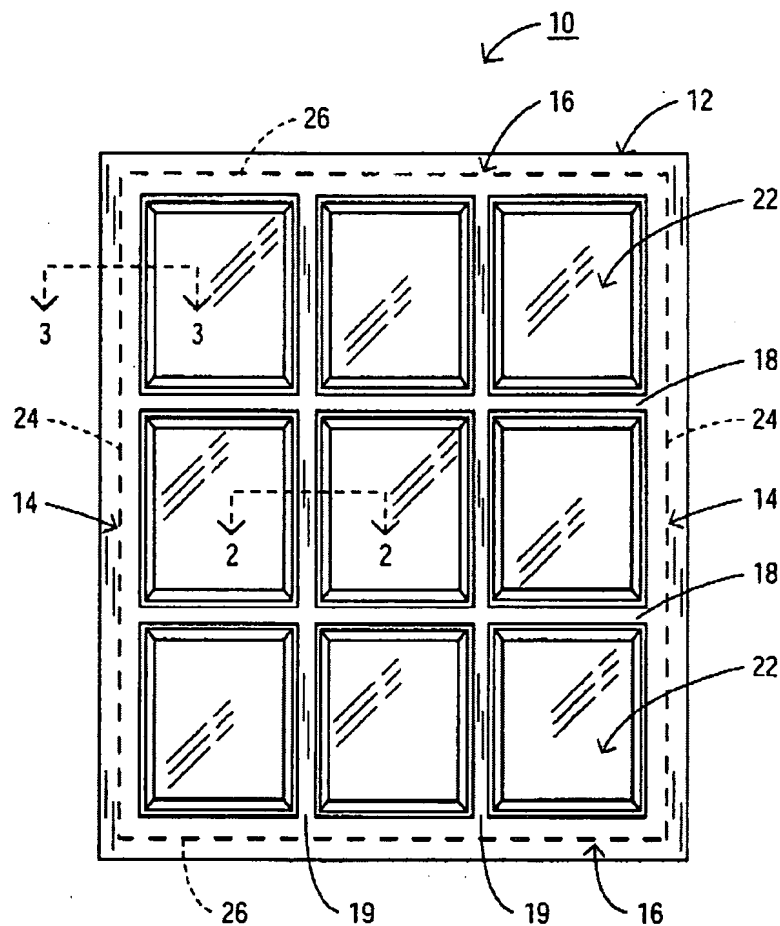


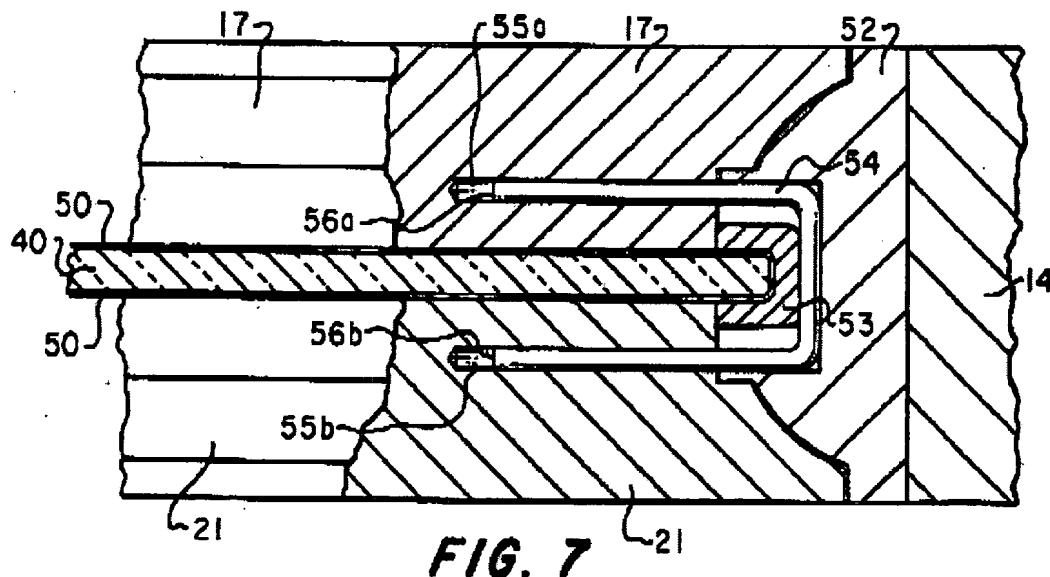
FIG. 1

- b. Eichhorn does not expressly disclose the welding of the sheet metal plate to a frame element.
- c. Stibolt teaches that when connecting two metal plates, it is common knowledge in the art to use the method of welding: "However, the preferred means of joining each miter-jointed end is to fuse or weld each end to each other." (paragraph 53, lines 6-8). The use of welding as taught by Stibolt provides an enhanced connection for the two plates by forming an air- and water-tight seal.
- d. The examiner further notes motivation for combining the references as set forth in Stibolt: by welding, "an air and water tight seal is formed between each adjacent portion" (paragraph 53, lines 8-9).
- e. Eichhorn and Stibolt are analogous art because both are from the same field of endeavor of window structures.
- f. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to connect the cover element to the frame element by welding the two together. Furthermore, it would have been obvious to make this modification in order to create an air- and water-tight seal between the elements.
- g. The examiner notes that due to the phrase "incorporated by means of a cutting method," claim 1 is considered to be a product-by-process claim, and it has been held that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the

product itself. Additionally, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) {see MPEP 2113}.

4. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eichhorn (U.S. Patent No. 6,240,685) in view of Stibolt (U.S. Pub. No. 2003/0070370) as applied to claim 1 above, and further in view of Dazo (U.S. Patent No. 5,487,245).
 - a. Eichhorn in view of Stibolt discloses a cover element for the opening of a building as set forth above.
 - b. Eichhorn in view of Stibolt does not expressly disclose that a sheet metal plate facing a web of a frame leg projects on the edge side beyond the glass pane and is welded together with a side surface of the frame element extending perpendicular to the visible side of the cover element [claim 3], or that the glass pane is clamped between the sheet metal plates [claim 5].
 - c. Dazo discloses a sheet metal plate ("front muntin" 21, "back muntin" 17, Figure 7) facing a web of a frame leg ("stile trim" 52, Figure 7). The sheet metal plate projects on the edge side beyond the glass pane (Figure 7) [claim 3]. Dazo also discloses a glass pane ("unitary light transmissive sheet" 40, Figure 7) clamped between the sheet metal plates [claim 5].

- d. Stibolt teaches it is common knowledge in the art to connect two metal pieces using the method of welding. Therefore at the time of invention, it would have been obvious to a person of ordinary skill in the art to connect the side surface of the frame element to the visible side of the cover element by welding them together.
- e. Eichhorn, Stibolt, and Dazo are analogous art because both are from the same field of endeavor of window structures.
- f. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the welding method of Stibolt to connect the cover element of Eichhorn in view of Stibolt with a side surface, since welding is known to provide strong connections between welded members.



5. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eichhorn (U.S. Patent No. 6,240,685) in view of Stibolt (U.S. Pub. No. 2003/0070370) as applied to claim 1 above, and further in view of DeBlock et al. (U.S. Patent No. 6,546,682).
- a. Eichhorn in view of Stibolt discloses a cover element for the opening of a building as set forth above.
 - b. Eichhorn in view of Stibolt does not expressly disclose that the sheet metal plate rests on a web projecting in the cross section of the respective frame element [claim 6], or that a sealing profile is arranged between a sheet metal plate and the web of the frame element [claim 7].
 - c. DeBlock et al. discloses a sheet metal plate (outside edges of “door” 100, Figure 3) resting on a web (“door-engagement flange” 46, Figure 3) projecting into the cross section of the respective frame element [claim 6]. A sealing profile (“gasket” 80a, Figure 3) is arranged between the sheet metal plate and frame element web [claim 7].
 - d. Eichhorn, Stibolt, and DeBlock et al. are analogous art because both are from the same field of endeavor of door structures.
 - e. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the cover element of Eichhorn in view of Stibolt to use a web and sealing profile to secure the sheet metal plate to the framing element as taught by DeBlock et al., since the web and sealing profile are known to create a strong connection.

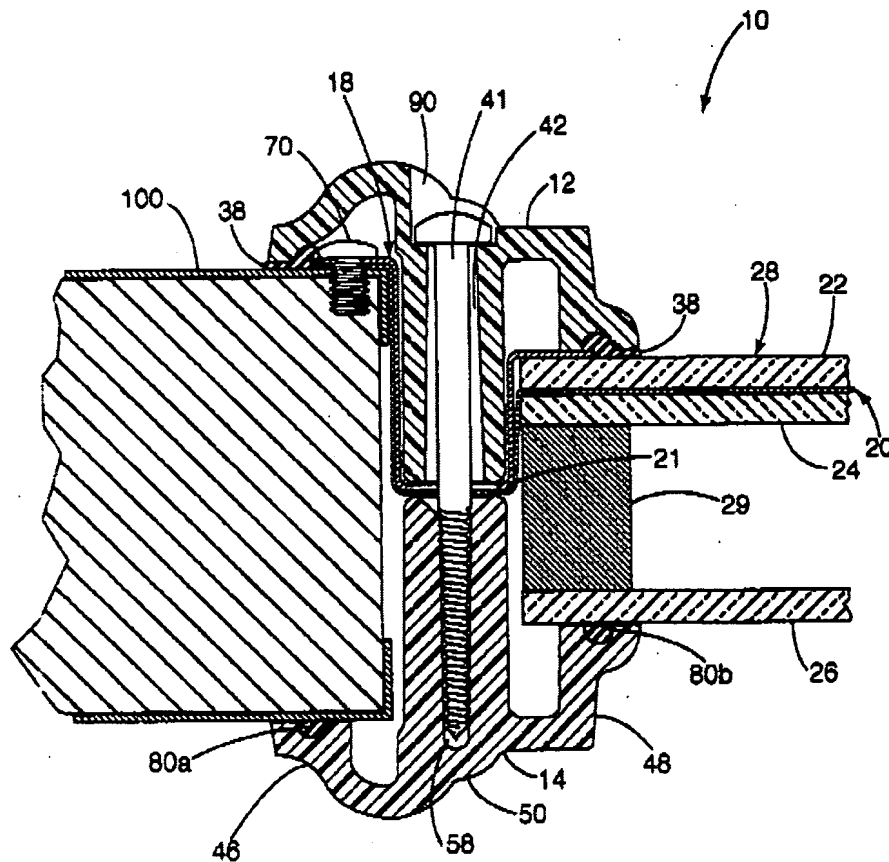


Fig. 3

Reproduced from U.S. Patent No. 6,546,682

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eichhorn (U.S. Patent No. 6,240,685) in view of Stibolt (U.S. Pub. No. 2003/0070370) as applied to claim 1 above, and further in view of Huynh (U.S. Patent No. 7,104,015).
- a. Eichhorn in view of Stibolt discloses a cover element for the opening of a building as set forth above.
 - b. Eichhorn in view of Stibolt does not expressly disclose an intermediate layer of cellular rubber arranged between the glass pane and the sheet metal plates.

- c. Huynh discloses a gasket ("glazing gasket" 32, Figure 2a) serving as an intermediate between a glass pane ("glass pane" 20, Figure 2a) and a metal plate ("glazing frame" 14, Figure 2a; "A glazing frame 14 is also made of a metal or other suitable material," column 2, lines 50-51). The use of the intermediate gasket provides the assembly with a water-tight seal.
- d. Eichhorn in view of Stibolt, and further in view of Huynh discloses the claimed invention except for the specific use of cellular rubber. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the gasket out of cellular rubber, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.
- e. The examiner further notes motivation for combining the references as set forth in Huynh: "Application of glazing gasket 32 or sealant 54 provides water-tight result to the window assembly" (Abstract).
- f. Eichhorn, Stibolt, and Huynh are analogous art because both are from the same field of endeavor of window structures.
- g. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Eichhorn as taught by Huynh to add a layer of rubber material between the glass pane and sheet metal plate in order to form a water-tight seal.

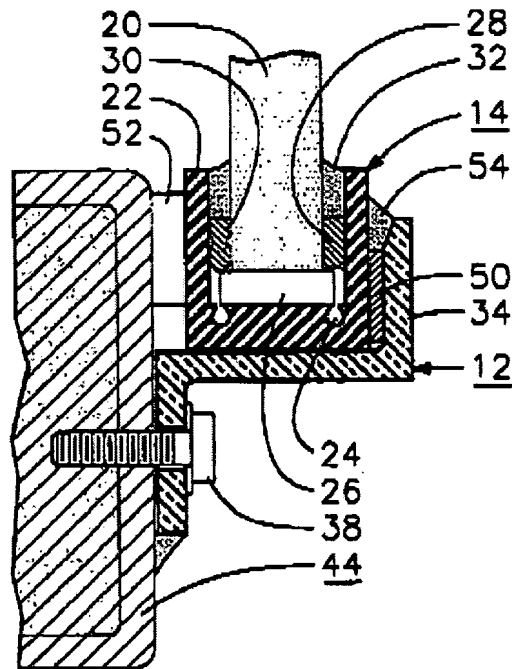


FIG. 2A

Reproduced from U.S. Patent No. 7,104,015

Allowable Subject Matter

7. Claims 2 and 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 08/21/07 have been fully considered but they are not persuasive.

9. Applicant argues that his frames are made of a sheet metal plate in which cut-outs are arranged. However, amended claim 1 recites "the glass pane and the sheet-metal plate being arranged within frame elements," which suggests the frame and sheet-metal plates are different elements, and contradicts applicant's argument.
10. Applicant correctly states that Eichhorn does not explicitly disclose a welded connection between the metal plates and the surrounding frame; that said, Eichhorn does disclose a connection between the metal muntins and the surrounding frame ("The simulated muntins may be attached to the support frame by nailing, tacking, gluing, screwing, or any other suitable attachment means," column 2, lines 37-40). Claim 1 is rejected under Eichhorn in view of Stibolt because Stibolt teaches that welding is a well-known connection means between two pieces of metal.
11. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
12. Applicant further argues that the combination of Eichhorn in view of Stibolt would not lead to the plate-like cover element recited in claim 1. The examiner again notes that Eichhorn discloses the claimed invention except for a welded connection, and that Stibolt teaches welding as a well-known connection means in the art.

Art Unit: 3635

13. The examiner further notes that welding is notoriously well-known in the art, and that any person of ordinary, or even less than ordinary, skill in the art would be familiar with welding as a connection means.
14. In response to applicant's argument that Eichhorn and Stibolt are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Eichhorn and Stibolt both relate to the window art ("A decorative building unit simulating a multi-pane, window or door," Eichhorn Abstract; "Window Wrap," Stibolt title). In light of the relation of the references, it is clear that these would, in fact, be considered in combination by one skilled in the art.
15. Applicant further argues that mere knowledge of welding is not sufficient to lead to the connection of two metal pieces, nor does it suggest where elements should be welded together. The examiner notes that Eichhorn discloses connecting the metal muntins to the surrounding frame, and that one of ordinary skill in the art would certainly realize that this connection should be made in such a way and at such positions to produce the multi-pane structure disclosed by Eichhorn.
16. The applicant's final argument is that claims 3, 5, 6, 7, and 8 are patentable because they depend from amended claim 1. It has been shown above that amended claim 1 is not patentable. Since no specific arguments have been made

regarding the combinations used in the rejections of claims 3 and 5-8, these claims stand rejected without further discussion.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

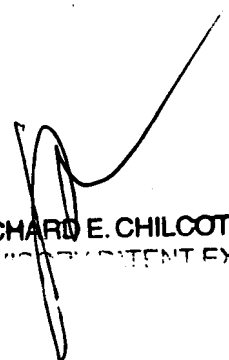
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Branon C. Painter whose telephone number is (571) 270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Branon Painter
10/29/07



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SUPERVISOR, PATENT EXAMINER